

App1. No. 09/896,928
Amendment/Response
Accompanying RCE

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REMARKS

Claims 1, 5-7, 23, 31, 33-37 and 39-45 are pending in the instant application.

Allowed Claims

Applicants gratefully acknowledge the indication of allowance of claims 5 and 7.

Objected to Claim

The objections to claims 1, 5-7 and 33 are moot in view of the present amendment.

Rejections under 35 USC § 102(b)

Claims 1 and 6 were rejected under 35 USC § 102(b) as being anticipated by U.S. Patent 4,884,294 to *Inagami*. For at least the reasons that follow, it is respectfully submitted that this rejection is improper and should be withdrawn.

A proper rejection for anticipation requires, as the first step in the inquiry, that all the elements of the claimed invention be described in a single reference. A necessary corollary to the test of anticipation is that the absence from the reference of any claimed element negates anticipation.

Claim 1 is drawn to a cordless phone and features:

"...a handset, including an alerting mechanism responsive to the paging mechanism, wherein the paging mechanism and alerting mechanism are for use in locating a missing handset..."

Claim 6, as amended, includes a similar feature.

By contrast, the reference to *Inagami* discloses a PAGE PBS (push button switch) on the base station 5. *Inagami* teaches that the paging function is to affect the volume depending on whether the person with the portable cordless phone is "talking" or "not talking", which is not related to location. To this end, there are two states related to a Paging function. In the first page state, the user is talking on the phone, and in the next page state, the user is not talking on the phone. As described, for example, in Column 5,

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line 54, when in the "Paging during talking" state, the sound level is low, and when in the "Paging when not talking" state the sound level is high.

However, the reference to *Inagami* does not describe the function of the paging, and especially does not disclose a paging mechanism and alerting mechanism for use in locating a missing handset. In fact, it is respectfully submitted that the handset of *Inagami* is not missing. To this end, when the person is talking on the handset, the handset cannot be missing. Thus, a paging and alerting mechanism drawn to finding a missing handset is supererogatory to *Inagami*.

Accordingly, and for at least the reasons set forth above, it is respectfully submitted that the reference to *Inagami* fails to disclose at least one of the features of claims 1 and 6. Therefore, a *prima facie* case of anticipation of claims 1 and 6 based on *Inagami* has not been established, rendering claims 1 and 6 allowable over the applied art. Allowance is earnestly solicited.

2. Claims 31 and 33-37 were rejected under 35 USC § 102(a) as being anticipated by EP 0876040 A1 to *Hardouin*. For at least the reasons set forth below, these claims are patentable over the applied art.

Independent claims 31-33 are drawn to a method of affecting an alerting signal of a telephone handset. The methods of these claims each feature *paging the telephone handset via the alerting signal*.

By contrast *Hardouin* is drawn to a wireless telecommunications switching mechanism that determines the base station on which a wireless handset is registered and uses information concerning background noise at the location of the base station to automatically adjust ringer and voice volumes for each call received at the wireless handset while registered at the base station. There is no disclosure of paging a telephone handset via an alerting signal as featured in claims 31-33.

Accordingly, and for at least the reasons set forth above, it is respectfully submitted that the reference to *Hardouin* fails to disclose at least one of the features of claims 31-33. Therefore, a *prima facie* case of anticipation of claims 31-33 based on *Hardouin* has not been established, rendering claims 31-33 and the claims that depend

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therefrom allowable over the applied art. Allowance is earnestly solicited.

Rejections under 35 USC § 103(a)

1. Claims 23 and 39-41 were rejected under 35 USC § 103(a) as being unpatentable over *Inagami* in view of *Dennerlein* (U.S. Patent 5,117,504). For at least the reasons set forth herein, it is respectfully submitted that these claims are patentable over the applied art.

As noted in the previous response, the Office Action states that "*Inagami* clearly shows and discloses a method of affecting a page alerting signal of a telephone handset [by] . . . sensing a condition related to a location of the handset 1 (i.e., the distance between the user (e.g., when pressing the PAGE PBS (push button switch) (paging mechanism) as a base unit 5) and the handset 1) (figures 2-4 and 8, column 5, line 54 – column 6 line 6, and column 7 lines 1-50)". Consistent with the discussion surrounding claims 1 and 6, *Inagami* merely teaches that the paging function is to affect the volume depending on whether the person with the portable cordless phone is "talking" or "not talking." However, the paging function is not related to the location of the handset. Thus, the reference to *Inagami* lacks at least the disclosure of one of the features of claim 23.

While Applicants in no way concede the propriety of the combination of *Dennerlein* or the propriety of the rejection based thereon, because a proper rejection based on *Inagami* cannot be made, a discussion of the shortcomings of *Dennerlein* is foregone at this time.

For at least the reasons set forth above it is it is respectfully submitted that the reference to *Inagami* fails to disclose at least one of the features of claim 23. Therefore, a *prima facie* case of obviousness of claim 23 based on *Inagami* has not been established, rendering claim 23 and the claims that depend therefrom allowable over the applied art. Allowance is earnestly solicited.

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2. Claims 42-45 are rejected over *Inagami* in combination with *Alvarez* (U.S. Patent 5,805,667).). For at least the reasons set forth herein, it is respectfully submitted that these claims are patentable over the applied art.

Claim 42 features "...sensing a condition related to a location of the handset..."

As discussed in detail previously, *Inagami* merely teaches that the paging function is to affect the volume depending on whether the person with the portable cordless phone is "talking" or "not talking." However, the paging function is not related to the location of the handset. Thus, *Inagami* does not teach sensing a condition related to a location of the handset and affecting an alerting signal based thereon. Accordingly, the reference to *Inagami* lacks at least the disclosure of one of the features of claim 42.

While Applicants in no way concede the propriety of the combination of *Alvarez* or the propriety of the rejection based thereon, because a proper rejection based on *Inagami* cannot be made, a discussion of the shortcomings of *Alvarez* is foregone at this time.

For at least the reasons set forth above it is it is respectfully submitted that the reference to *Inagami* fails to disclose at least one of the features of claim 42. Therefore, a *prima facie* case of obviousness of claim 42 based on *Inagami* has not been established, rendering claim 42 and the claims that depend therefrom allowable over the applied art. Allowance is earnestly solicited.

Conclusion

In view of the foregoing, applicant respectfully requests withdrawal of the above noted rejection of record, the allowance of all pending claims, and the holding of this application in condition for allowance. If any points remain of issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Except as otherwise stated in the above noted Remarks, Applicant notes that each of the amendments have been made to place the claims in better form for U.S. practice,

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not to distinguish the claims from prior art references, otherwise narrow the scope of previously pending claims or comply with other statutory requirements.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any required fees including, but not limited to, any fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact William S. Francos, Esq. (Reg. No. 38,456) at (610) 375-3513 to discuss these matters.

Respectfully submitted on behalf of:
Agere Systems, Inc.


by: William S. Francos (Reg. No. 38,456)

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